

Remarks/Arguments:

Amendments

No amendments have been made.

First Rejection under 35 USC 103(a)

Claims 1-8 were rejected as unpatentable over the combination of Yoshinaka, U.S. Patent 6,596,434 ("Yoshinaka"), and the admitted prior art, namely Figures 4a and 4b as well as the description at the top of page 11 of the specification. This rejection is respectively traversed.

Figures 4a and 4b, the admitted prior art, show a conventional alkaline storage battery. As disclosed in the specification, a conventional alkaline storage battery does not have metal current collector 1, having a cap-shaped terminal and doughnut-like sealing plate 2. Specification, page 10, line 24, to page 11, line 3.

The Office admits that Yoshinaka does not explicitly teach a terminal of the upper collector is disposed through a hole in the center of the sealing plate. Office action of 07/26/07, page 3, lines 4-5. Thus, neither of the references relied on by the Office teach a terminal of the upper collector is disposed through a hole in the center of the sealing plate so that this feature of the invention is missing from the combination. Consequently, combination of the applied references in the manner proposed by the Office does not produce applicants' invention.

To provide the missing features of applicants' invention, the Office asserts that the two piece terminal shown in Figure 1 of the specification is an "obvious variant" of the single piece terminal and sealing plate as shown in Figures 1-5 of Yoshinaka, and (2) the battery cap assembly of the claimed invention and the battery cap assembly of Yoshinaka are "obvious variants" of each other. *Id.*, page 3, lines 9-11.

No explanation, reasoning and/or evidence is given as to why the person of ordinary skill in the art would envision these "obvious variants."

The Office does assert that "one of skill would reasonably expect them to function the same." *Id.*, page 3, lines 9-11. The person of ordinary skill in the art might be able to determine whether or not the structures contained in applicant's invention, once envisioned, would function in the same manner as those of Yoshinaka. However, it does not explain how or why one of ordinary skill in the art would envision these features in the first place.

The Office has provided no other support or justification for the assertion that the features of the applicant's invention are "obvious variants" of Yoshinaka. It has provided no explanation as to why the person of ordinary skill in the art would envision these features of applicant's invention from the teachings of Yoshinaka, which the Office admits does not disclose them. The only disclosure in the record that shows these features is applicants' disclosure. Thus, the rejection relies on applicants' disclosure. This is improper. *See, W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

The Office has not made the *prima facie* case. A finding of obviousness must be supported by the record. *See, In re Lee*, 61 USPQ2d 1430, 1432-34 (Fed. Cir. 2002) (agency findings must be supported by the record); *see also KSR International Co v. Teleflex Inc.*, 530 U.S. --, --, 82 USPQ2d 1385, 1396 (2007) (to facilitate review, analysis leading to conclusion of obviousness should be made explicit). Because (1) combination of the applied references in the manner proposed by the Office does not produce applicants' invention, and (2) the finding of obviousness is not supported by the record, the rejection of claims 1-8 as unpatentable over the combination of Yoshinaka and the admitted prior art is improper and should be withdrawn.

Second Rejection under 35 USC 103(a)

Claims 1-6 and claim 8 were rejected as unpatentable over the combination of Han, U.S. 5,837,396 ("Han"), and the admitted prior art. This rejection is respectively traversed.

The Office admits that Han does not explicitly teach a terminal of the upper collector is disposed through a hole in the center of the sealing plate. *Id.*, page 4, lines 4-5. Thus, neither of the references relied on by the Office teach a terminal of the upper collector is disposed through a hole in the center of the sealing plate so that this feature of the

invention is missing from the combination. Consequently, combination of the applied references in the manner proposed by the Office does not produce applicants' invention.

To provide the missing features of applicants' invention, the Office asserts that (1) the two piece terminal shown in Figure 1 of the specification is an "obvious variant" of the single piece terminal and sealing plate as shown in Figure 2 of Han, and (2) the battery cap assembly of the claimed invention the battery cap assembly of Han are "obvious variants." *Id.*, page 4, lines 8-11.

The Office has provided no other support or justification for the assertion that the features of the applicant's invention are "obvious variants" of Han. It has provided no explanation as to why the person of ordinary skill in the art would envision these features of applicant's invention from the teachings of Han, which the Office admits does not disclose them. Figure 2 of Han, for example, shows an un-numbered structure that appears to be a lead tab similar to other prior art lead tabs, for example, Yoshinaka's lead tab 9, shown in Yoshinaka's Figure 1, and lead **11** shown in applicant's Figure 4a, the admitted prior art.

The only support offered for this position is that "one of skill would reasonably expect them to function the same." *Id.*, page 4, lines 8-11. As discussed above, the person of ordinary skill in the art might be able to determine whether or not the structures contained in applicant's invention, once envisioned, would function in the same manner as those of Han. However, it does not explain how or why one of ordinary skill in the art would envision these features in the first place. The only disclosure in the record that shows these features is applicants' disclosure. Thus, the rejection relies on applicants' disclosure. This is improper. See, *Gore* 220 USPQ at 312-313.

The Office has not made the *prima facie* case. A finding of obviousness must be supported by the record. Because (1) combination of the applied references in the manner proposed by the Office does not produce applicants' invention, and (2) the finding of obviousness is not supported by the record, the rejection of claims 1-6 and 8 as unpatentable over the combination of Han and the admitted prior art is improper and should be withdrawn.

Response to Office Arguments

The Office argues that any judgment of obviousness is based on hindsight, but as long as it take into account that was within the level of ordinary skill at the time the invention was made and does not include knowledge gleaned from applicants' disclosure, such a rejection is proper.

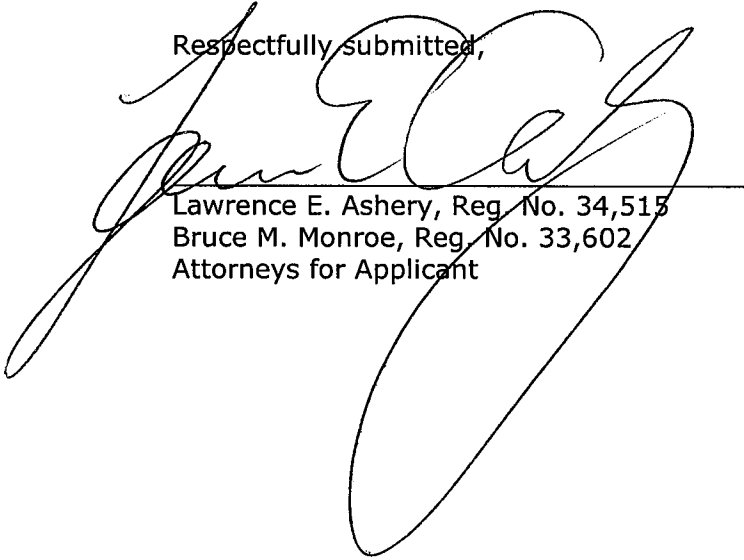
The Office repeats the previous statements that one of ordinary skill in the art would have found the features of applicants' invention missing from the applied references to be "obvious variants" of the prior art because one of ordinary skill in the art would reasonably expect them to function the same. *Id.*, page 5, lines 8-12, and page 5, line 21, to page 6, line 1.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103." *In re Kahn*, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (internal citations omitted). An analysis of function by the person of ordinary skill in the art would occur after the features have been envisioned. Missing from the Office response is any explanation or reasoning as to how or why the person of ordinary skill in the art would envision these features in the first place. Consequently, these features have been improperly gleaned from applicants' disclosure. This is improper, and the rejection should be withdrawn.

Conclusion

It is respectfully submitted that the claims are in condition for immediate allowance and a notice to this effect is earnestly solicited. The Examiner is invited to phone applicant's attorney if it is believed that a telephonic or personal interview would expedite prosecution of the application.

Respectfully submitted,



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